

Appl. No.: 10/075,580
Amdt. Dated: 07 February 2004
Reply to Office Action mailed 10/07/03

REMARKS/ARGUMENTS

In the Office Action mailed 10/07/03 the Examiner has rejected claims 1-20 under 35 U.S.C.103(a) as being unpatentable over Penney (US 471,891) in view of Everett (US 5,896,955).

In rejecting the claims the Examiner refers to previous discussions of Penny and Everett in paper number 5 mailed 05/21/2003 and paper number 2 mailed 11-22-2002. In these papers the Examiner alleges that Penny (US 471,891) shows a brake having plural pads B slidably fit onto shoe body A, the claimed invention differing only in the intended use, and in using pads having varying braking characteristics as disclosed in Everett. It is submitted that the Examiner's reasons for rejection are not explicitly stated, however, apparently the Examiner is alleging that the claimed invention is obvious from the wooden wagon brake of Penny somehow modified with the pads having different braking characteristics as disclosed in Everett. Such rejection is respectfully traversed in accordance with the reasons presented below.

Penny discloses a metal brake shoe body having a flanged recess for sequentially and replaceably receiving therein a plurality of brake blocks of wood, or other suitable materials such as metal or rawhide. The blocks are slid crosswise, or transversely into recess *c* in abutting relationship, the blocks restrained in recess *c* by flange *e*. The recess *c* has a block stop, or closed end, in the form of a ledge *d*. The blocks are captured at the open end by a keeper in the form of a bolt or rod *f* inserted transversely across the recess *c*. The brake shoe is curved in the longitudinal direction in a concave manner to conform to the curvature of the face of the wagon wheel with the brake blocks applied directly to the face of the wheel. Thus, the brake shoe is configured to engage the blocks along a curved contact surface. The blocks are fully recessed within the brake shoe with the flange *e* riding on the outside of the wheel.

Briefly then, the teachings of Penny are to provide a brake shoe curved conforming to the curvature of the wheel surface having removable wood brake blocks captured and contained

entirely within a flanged recess in the brake shoe; the blocks applied directly to the road contact surface of the wheel. The only similarity in the device of Penny and that of applicant's invention is that the brake means of Penny are replaceably installed entirely in a flanged recess in the casting of a brake shoe. There is absolutely no suggestion, much less a teaching, in Penny of at least the following that is taught and claimed by applicant:

- the blocks being of different compounds having different braking characteristics;

- the brake shoe being planar longitudinally with the block surfaces being coplanar with each other;

- the block surfaces applied directly to the sides of the wheel;

- the blocks formed having a top portion within the flanges *e* and a bottom portion extending from the flange *e* for contact with the side of the wheel, the top and bottom portions defined by an indentation that is captured by the flange *e*;

- the brake shoe having longitudinal sidewise curvature in conformance with the radius of the wheel.

It is thus clear that the sole disclosure and teachings of Penny is simply to slidably replace wheel surface contact brake blocks of then conventional materials when they become worn; not when different braking characteristics are desired.

Everett discloses in one embodiment a main body brake pad with a removable insert portion totally enclosed by the main portion, the main body portion and the insert portion being of different braking compounds for providing different braking characteristics. In another embodiment (Figure 5) there is disclosed more than one brake pads of different braking compounds for providing different braking characteristics, there again being a main body portion with the pad portions formed entirely within the main body portion. The different pad portions are either formed as snap inserts in the main body portion or molded unitarily with the main body portion. There is absolutely no suggestion, much less a teaching, in Everett of, at least, the brake pad portions be individually molded as separate pads, or that such pads be longitudinally, sequentially and replaceably inserted into a recess in the brake shoe.

As to rejection under 35 U.S.C. 103(a), the mere fact that the prior art may be modified in a manner suggested by the Examiner does not make the modification obvious unless the prior art

suggested the desirability of the modification In re Gordon, 723 F.2d at 902, 221 USPQ at 1127. It is abundantly clear that there is absolutely no suggestion in either Penny or Everett of the desirability that the teachings of Penny could somehow be modified with the teachings of Everett to result in applicant's claimed invention. Thus, the Examiner has not met the requirement of In re Gordon, and for this reason the Examiner's rejections must fail.

Further, it was variously held in Ex parte Warhol, 94 USPQ 193 and in In re Irmischer, 120 USPQ 196, that;

references may be combined to anticipate a claim, but their teachings must be capable of suggesting to one skilled in the art, without exercising inventive faculties, their combination in a manner disclosed in the claimed structure; and

the claim will be allowed where one skilled in the art, with the prior art before him, but in the absence of applicant's disclosure, would be incapable of constructing the claimed structure without displaying creative genius.

First, in view of the above, it is abundantly clear that there is no nexus between Penny and Everett such that their teachings are capable of suggesting to one skilled in the art, without exercising inventive faculties, their combination in a manner disclosed in the claimed structure. Further, in view of the above it is clear that without applicant's disclosure one skilled in the art would be incapable of constructing the claimed structure without displaying creative genius.

As a simple example, if one takes the a block of Penney and replaces it with a transverse pad of Everett having inserts and/or moldings contained entirely within a body portion, the resulting device would not work since the different compounds would engage the wheel surface simultaneously. Thus, the concept of turning the blocks of Penny 90% must be envisioned, otherwise the blocks would have to be each of different compounds, which is not taught by Everett. There still remains at least the concept of somehow modifying the device of Penny such that the brake shoe is planar and curved to be applied to the sides of the wheel. From this simple example it is seen that even if the teaching of Penny and Everett were somehow combined as vaguely suggested by the Examiner, there would not even result a workable device, much less applicant's claimed invention. Obviously the teachings of the claimed invention are necessary to somehow modify the device of Penny.

Thus, the Examiner has not met the requirements of Ex parte Warhol, 94 USPQ 193 and/or In re Irmischer, 120 USPQ 196 and for this reason the Examiner's rejections must fail.

It is therefore submitted that the Examiner has made a "hind-sight" rejection in that only with applicant's disclosure can one skilled in the art be capable of constructing applicant's claimed structure without exercising inventive faculties.

In view of the above, it is submitted that the Examiners burden has not been met under 35 U.S.C.103(a) in that the limitations contained in applicant's amended claims are neither taught nor suggested in Penny, Everett, or the combination thereof. It is thus respectfully requested that the Examiner's rejections be reconsidered and the claims in the case, that is amended independent claims 1, 8 and 15, and claims 2-7, 9, 10, 12-14 and 16-20 variously dependent therefrom, be allowed and the case passed to issue.

A petition and the required fee of \$55.00 for a one-month extension of time to reply is enclosed herewith.

Respectively submitted,

 02/07/04

Edward E. Roberts

Date

Attorney for Applicant

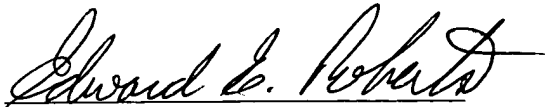
(949) 365-5717

P.O. Box 3206

Dana Point, CA 92629

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service, postage prepaid, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on 07 February 2004.



Edward E. Roberts

Reg. No. 26,024